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EXAMINER

MOHANDESI, JILA M

ART UNIT

PAPER NUMBER

3728

DATE MAILED: 11/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/827,933

Applicant(s)

SCHMID, RAINER K.

Examiner

Jila M Mohandesi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04/09/01 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____.

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the plurality of layers of Carbon graphite must be shown or the feature(s) canceled from the claim (11). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-4 and 6-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claims 1, 8 and 20, the phrase, "in multiple dimension" is vague and indefinite. It is not clear what structure such language encompasses.

In claims 22, 26 and 30, the phrase, "in all dimension" has no clear meaning rendering the claim indefinite.

In claims 24, 28 and 32, the phrase, "are not fixed to one another in any dimension", is inaccurate, vague and indefinite. The Figures clearly show the first and second rigid plates being fixed to one another.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 7-8, 14, 18-19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Beyl (5,282,325). Beyl `325 discloses an article of footwear comprising: an upper; an outsole defining a ground engaging surface; a sole disposed between said upper and said outsole, said sole including an energy return system; wherein said energy return system comprises a first rigid plate (2), a second rigid plate (3) spaced a predetermined distance from first rigid plate, and at least one separating element (R) disposed therebetween to maintain the spacing between said plates. The separating element does allow independent movement of the first and second rigid plates with respect to one another.

All the functional claim language and statements of intended use do not make an otherwise unpatentable claim patentable. It is believed to be settled that "recitation with respect to manner in which claimed apparatus is intended to be employed does not differentiate claimed apparatus from the prior art apparatus satisfying structural limitations of that claimed, " *Ex parte Masham* 2 USPQ2nd 1674. Also *Ex parte Casey* 152 USPQ 235. The law of anticipation does not require that an anticipatory reference teach what the applicant is claiming or has disclosed, but only that the claims "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the

reference. See *Kalman v. Kimberly Clark Corp.*, 713 F.2d 760, 218 USPQ 871 (Fed Cir. 1983). Furthermore, it is only necessary that the reference include structure capable of performing the recited function in order to meet the functional limitations of the claim. See *In re Mott*, 557 F.2d 266, 194 USPQ 305 (CCPA 1977). Since the reference device has all of the same structural elements, as noted above, it would clearly seem to be inherently capable of performing the functions as claimed. Note also that most of the distinctions argued are not present in the claims.

6. Claims 1, 6-8, 12, 18-19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Sabol (5,343,636). Sabol '636 discloses an article of footwear comprising: an upper; an outsole (121, 122) defining a ground engaging surface; a sole disposed between said upper and said outsole, said sole including an energy return system; wherein said energy return system comprises a first rigid plate (11), a second rigid plate (12) spaced a predetermined distance from first rigid plate, and at least one separating element (13) disposed therebetween to maintain the spacing between said plates. The separating element does allow independent movement of the first and second rigid plates with respect to one another. See Figures 1, 2b and 3a embodiments.

With respect to claim 6, see the separating element of Fig 3a.

All the functional claim language and statements of intended use do not make an otherwise unpatentable claim patentable. It is believed to be settled that "recitation with respect to manner in which claimed apparatus is intended to be employed does not differentiate claimed apparatus from the prior art apparatus satisfying structural

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limitations of that claimed, “ *Ex parte Masham* 2 USPQ2nd 1674. Also *Ex parte Casey* 152 USPQ 235. The law of anticipation does not require that an anticipatory reference teach what the applicant is claiming or has disclosed, but only that the claims “read on” something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See *Kalman v. Kimberly Clark Corp.*, 713 F.2d 760, 218 USPQ 871 (Fed Cir. 1983). Furthermore, it is only necessary that the reference include structure capable of performing the recited function in order to meet the functional limitations of the claim. See *In re Mott*, 557 F.2d 266, 194 USPQ 305 (CCPA 1977). Since the reference device has all of the same structural elements, as noted above, it would clearly seem to be inherently capable of performing the functions as claimed. Note also that most of the distinctions argued are not present in the claims.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2-3, 9-11, 12-13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beyl `325 in view of Schmid (4,858,338). Beyl `325 as described above discloses all the limitations of the claims except for the specifics of the material of the rigid plates. Schmid `338 discloses an insert/sole (20) for an article of footwear where the insert/sole absorbs, stores and returns the kinetic energy of a wearer to the wearer's foot. The insert/sole (20) is made of an elastic material which is defined as a

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high tensile strength material which has a modulus of elasticity of at least 32X10 lb/in made of a plurality of Graphite fibers. Graphite fibers have the advantages that they have a high tensile strength, a high modulus of elasticity, are lightweight, and can be easily processed. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the rigid plates of Beyl '325 from plurality of Graphite fibers as taught by Schmid '338 to enhance the energy return properties of the energy return system. Furthermore, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

With respect to claim 13, the insert/sole of Schmid '338 discloses a rocker bottom (28) to cradle the first metatarsal head of the foot of the wearer. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a rocker bottom to the first and second rigid plates of Beyl '325 as taught by Schmid '338 to better cradle the foot of the wearer.

With respect to claims 12 and 15 which further limits the size of the rigid plates, it would have been obvious to one having ordinary skill in the art to modify and/or alter the size of the rigid plates in order to make the article of footwear more energy efficient and/or as an obvious choice of design or as a matter of routine optimization since it would appear they would work equally well in any of a variety of sizes.

9. Claims 4-5, 16-17 and 21-32 are rejected under 35 U.S.C. 103(a) as being obvious over Sabol '636. With respect to claims 4 and 16 which further limit the material of the separating element (13), it would have been obvious to one of ordinary skill in the

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art at the time the invention was made to modify the material of the separating element since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

With respect to claims 5, 17, 21-23 and 25-32, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide two separating elements instead of one in the energy return system of Sabol '636 to enhance the energy return system, since it has been held that mere duplication and rearranging of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. V. Bemis Co.*, 193 USPQ 8 and *In re Einstein*, 8 USPQ 167.

Response to Arguments

10. Applicant's arguments filed July 18, 2002 have been fully considered but they are not persuasive. Contrary to applicant's arguments, the separating elements of Beyl '325 and Sabol '636 does allow independent movement of the first and second rigid plates with respect to one another.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jila M Mohandesi whose telephone number is (703)305-7015. The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (703) 308-2672. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

Jila M Mohandesi
Examiner
Art Unit 3728

JMM
October 22, 2002



Mickey Yu
Supervisory Patent Examiner
Group 3700

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